

*DA 622 \$*

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**TRANSMITTAL LETTER AND  
 AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

ASSISTANT COMMISSIONER FOR PATENTS  
 WASHINGTON, D.C. 20231

**RECEIVED**

JUL 19 2004

**OFFICE OF PETITIONS**

RE: Attorney Docket No.: CAT/29US-SCRO-CO3

Application Serial No.: 09/756,788

Filed: 1/10/2001

Title: System and Method for Providing Shopping Aids and Incentives to  
 Customers Through a Computer Network

Inventor: SCROGGIE et al.

Group Art Unit: 3622

Examiner: Stephen GRAVINI

**RECEIVE!**

JUL 22 2004

**GROUP 3600**

SIR:

Attached hereto for filing are the following papers:

37 CFR 1.81 Petition to Remove Final Status

Our check in the amount of \$130.00 are attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.

31518  
 PATENT TRADEMARK OFFICE

7/15/04  
 Date

Richard A. Neifeld, Ph.D.  
 Registration No. 35,299  
 Attorney of Record

Printed: July 15, 2004 (12:14pm)

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JUL 19 2004

DOCKET NO: CAT29US-SCRCO3

PRIOR DOCKET NO.: 7791-7791-25-X CONT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE ~~OFFICE OF PETITIONS~~

IN RE APPLICATION OF: MICHAEL C. SCROGGIE ET AL.

GROUP: 3622

APPLICATION NUMBER: 09/756,788

CONTROL NO: 6599

EXAMINER: STEPHEN GRAVINI

FILED: January 10, 2001

FOR: SYSTEM AND METHOD FOR SHOPPING  
AIDS AND INCENTIVES TO CUSTOMERS  
THROUGH A COMPUTER NETWORK

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**GROUP 3600**

ASSISTANT COMMISSIONER FOR PATENTS

WASHINGTON, D.C. 20231

37 CFR 1.181 PETITION TO REMOVE FINAL STATUS

07/16/2004 AWONDAF1 00000009 09756788

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130.00 OP

**I. Statement of the Precise Relief Requested**

The applicant requests that the Director remove the final status of this application.

**II. Statement of the Material Facts**

1. On March 15, 2004, the applicant filed an appeal brief, and also the notice of appeal and relevant fees for the appeal.

2. On May 4, 2004, the USPTO mailed an office action re-opening prosecution as authorized under 37 CFR 1.193(b)(2), not an examiner's answer.

3. The office action mailed May 4, 2004 contains new grounds of rejections for all claims, and it withdraws all prior rejections.

4. The office action mailed May 4, 2004 is FINAL.

5. The new grounds of rejection in the office action mailed May 4, 2004 were not necessitated by any action on the part of the applicant.

6. The 37 CFR 1.17 petition fee (\$130.00) is filed herewith.

**III. Reasons Why the Relief Requested Should be Granted**

An examiner is entitled to re-open prosecution after the filing of an appeal brief pursuant to 37 CFR 1.193(b)(2). The examiner is not entitled to both re-open prosecution and make the new office action final. The filing of an appeal brief is not an action on the part of the applicant necessitating a new ground of rejection.

The applicants actions (filing an appeal brief) did not necessitate new rejections. Accordingly, final status is improper and should be withdrawn. MPEP 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

This is a subsequent action on the merits in which new grounds for rejection were not necessitated by any action on the part of the applicant. Accordingly, final status is improper.

Respectfully submitted,

7/15/04

Richard Neifeld

Registration No: 35,299

Attorney of Record

Date/Time: July 15, 2004 (11:35am)

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